

REMARKS

Initially, the applicants would like to thank the examiner for the courtesies extended to the undersigned during the in-person interview of 10 June 2010. During the interview, the parties discussed the following remarks. Apparently, the present remarks should be considered the substance of the interview.

Non-elected claims 6-10 and 12-14 have been canceled without prejudice. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1, 4 and 11 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 6,240,555 to Shoff *et al.* (hereafter: "Shoff"). This rejection is respectfully traversed.

Claim 1 recites *inter alia* novel features associated with the exemplary embodiment described, for example, on pgs. 45-46 in which interactive control information included in a graphics stream stored on a recording medium includes a plurality of pieces of composition information defining a sequence of display compositions of graphics constituting an effect for introducing or removing a menu. Claim 1 further recites, as shown in, for example, Fig. 20, that each piece of composition information shows a duration after which the display composition is replaced by a subsequent composition in the bounding area. The graphics stream is overlaid on the moving pictures represented by a video stream.

As discussed further below, Shoff fails to disclose composition information showing a duration after which the display composition is replaced by a subsequent composition in the bounding area as called for in claim 1.

Shoff describes an interactive entertainment system in which a viewer computing unit 62 receives non-interactive continuous video and supplemental interactive content from the headend 22. For example, the supplemental interactive content can include a main menu having soft buttons (212-221) presenting control options to the viewer to invite interactive involvement with the program such as an encyclopedia of numerous facts and information, trivia games, etc.

The examiner has asserted that the soft buttons 212-221 disclose interactive control information including a plurality of pieces of composition information defining a sequence of display compositions of graphics constituting an effect for introducing or removing a menu. Particularly, during the interview, the examiner asserted that each or all of the soft buttons 212-221 are rendered with a bounding area on a graphics plane and introduce further menu options when pressed.

However, Shoff fails to even disclose the composition information for defining the soft buttons 212-221. Assuming *arguendo* that Shoff includes composition information for defining the soft buttons 212-221, Shoff still fails to disclose that the composition information shows a duration after which the display composition (soft buttons 212-221) is replaced by a subsequent display composition to be rendered within the same bounding area as called for in claim 1.

During the interview, the examiner stated that the soft buttons 212-221 of Shoff *inherently* disclose the recited duration. One example given by the examiner was a case in which the user changes from Star Trek to a different movie. According to the examiner, in such as case, the buttons would change, and thereby inherently disclose the limitation of showing a duration after which the display composition is replaced by a subsequent display composition to be rendered within the same bounding area. The applicants respectfully disagree with this contention. Even in the case described by the examiner, the buttons would only be replaced

based upon action of the user rather than a duration. That is, it would be unnecessary for the composition information defining the button to show a duration after which the display composition is replaced by a subsequent display composition to be rendered within the same bounding area.

If the examiner chooses to rely on the theory of inherency to support this rejection, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. See *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (MPEP 2112 IV).

As described in Shoff on col. 12, lines 30-35, the advantage of Shoff is permitting the developer to create and control location of both content and presentation format. Therefore, according to Shoff, the presentation format of the supplemental content may change according to the movie displayed. Accordingly, it does not necessarily flow from the description of Shoff to include composition information showing a duration after which the display composition (soft buttons 212-221) is replaced by a subsequent display composition to be rendered within the same bounding area.

Moreover, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (MPEP 2112 IV). Shoff does not disclose the presentation of the soft-buttons 212-221 when a movie title display is changed. Therefore, the examiner's contention amounts to mere speculation to what *may* occur when movie title display is changed.

Therefore, because Shoff fails to disclose interactive control information including a plurality of pieces of composition information defining a sequence of display compositions of graphics constituting an effect for introducing or removing a menu, wherein each piece of composition information shows a duration after which the display composition is replaced by a subsequent composition in the bounding area, it is respectfully requested that the rejection of claim 1, as well as dependent claim 4, under 35 U.S.C. 102(b) be withdrawn.

Claim 11 also recites the interactive control information includes a plurality of pieces of composition information defining a sequence of display compositions of graphics constituting the effect; and each piece of composition information shows a duration after which the display composition is replaced by a subsequent display composition to be rendered within the same bounding area. Accordingly, the rejection of claim 11 should be withdrawn for the above-mentioned reasons with respect to claim 1.

Claim 5 was rejected under 35 U.S.C. 103(a) as being unpatentable over Shoff in view of Applicant's admitted prior art (AAPA). This rejection is respectfully traversed.

Claim 5 recites *inter alia* the novel embodiment described, for example, on pg. 46 in which a set of graphics data associated with the in-effect is located in a string of the graphics data before a set of graphics data associated with the menu when the effect is an in-effect to be presented preceding the menu. As conceded by the examiner, Shoff does not expressly disclose this limitation. AAPA (background discussion of the application) has been cited in order to cure the deficient teachings of Shoff.

The background art discussion of the present application merely discusses user interfaces supporting presentation of pages within windows, and effects in response to menu calls by user. However, as discussed on pg. 2, lines 9-10, including an in-effect for providing a menu during

movie playback requires interruption of AV playback. Moreover, as discussed on pg. 2, lines 23-26, the bandwidth required for playing of the effects without interaction of AV playback is unpractical.

In Shoff, the concern is to supply interactive supplemental content to be played back along with continuous video content programs (see col. 1, lines 38-40 and col. 2, lines 56-58). Therefore, it would modify Shoff unsatisfactory for its intended purpose if it was modified as described in the prior art, so that the video content was interrupted while the supplemental content was played back.

Further, the AAPA *teaches away* from including the effects without interaction of AV playback due to the bandwidth requirements.

Therefore, the applicants respectfully disagree with the examiner's contention that one skilled in the art would have been motivated to combine Shoff with the effects discussed in the AAPA, because the AAPA describes presenting effects without interaction of AV playback as being unpractical. Accordingly, the rejection of claim 5 under 35 U.S.C. 103(a) should be withdrawn.

The indication of allowable subject matter in claim 3 is acknowledged and appreciated.

In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

Respectfully submitted,

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